Supreme Court, U.S.
FILED
NOV 18 2002
CLERK

(4)

No. 02-428

IN THE
SUPREME COURT OF THE UNITED STATES

DASTAR CORPORATION,
Petitioner,

v.

TWENTIETH CENTURY FOX FILM CORP., ET. AL
Respondents.

On Petition for Writ of Certiorari To The United States Court of Appeals for the Ninth Circuit

Amicus filling of Law Professors
Supporting Petition for Certiorari by Dastar Corp. as to Question One
Permission to file received from both parties.

Counsel of Record:
Malla Pollack
Visiting Associate Professor
Cecil C. Humphreys School of Law
University of Memphis
3715 Central Ave.
Memphis, TN 38152-3140
901-678-1393
mpollack@memphis.edu
(fax) 901-678-5210

18pp

Table of Contents

Table of Contents.....i

Table of Authorities.....ii

Interest of the *Amici Curiae*.....1

Summary of Argument.....1

Argument.....2

I. Granting *certiorari* in this case is an appropriate use of this Court's supervisory power over the federal court system.....2

A. Using the Lanham Act to extend copyright protection raises severe constitutional problems.....2

B. Congress has not legislated use of the Lanham Act to extend copyright protection.....5

C. This Court may solve the constitutional difficulty easily by requiring federal courts to heed statutory language.....7

II. Granting *certiorari* in this case would assist the Court in deciding *Eldred v. Ashcroft*.....8

III. A Court decision for Eldred would be almost a nullity unless *Dastar* is reversed.....10

Conclusion.....11

Table of Authorities

Cases

Bonito Boats Inc. v. Thunder Craft Boats, Inc.,
489 U.S. 141 (1989).....3

Christiansburg Garment Co. v. EEOC,
434 U.S. 410 (1978).....9

Cleary v. News Corp., 30 F.3d 1255(9th Cir. 1994).....5

Comedy III Productions, Inc. v. New Line Cinema,
200 F.3d 593 (9th Cir. 2000).....6

Dastar Corp. v. Twentieth Century Fox Film Corp,
No. 02-248 (U.S.), *cert. pet. from*
Twentieth Century Fox Film Corp. v.
Entertainment Distributing, No. 00-56703
(9th Cir., April 19, 2002) (reprinted Petition
for a Writ of Certiorari 1a), *aff'g*,
Twentieth Century Fox Film Corp. v.
Dastar Corp., No. CV 98-7189 FMC (Ex)
(C.D. Cal., Aug. 29, 2001) (reprinted
Petition for a Writ of Certiorari 7a) & (C.D. Cal.,
Jan 4, 2000) (reprinted Petition for a Writ of
Certiorari 30a).....*passim*

Eldred v. Ashcroft, No. 01-618 (U.S.).....2 & n.3; 8; 9; 10

Early v. Packer, No. 01-1765 (U.S., Nov. 4, 2002).....7 n.7

Feist Publications, Inc. v. Rural Tel. Svc. Co.,
499 U.S. 340 (1991).....3; 10 n.10

Dept. of Housing & Urban Dev. v. Rucker,
122 S. Ct. 1230 (2002).....5

INS v. St. Cyr, 533 U.S. 289 (2001).....5; 7

Kellogg Co. v. National Biscuit Co.,
305 U.S. 111 (1938).....3

M'Cullouch v. Md., 17 U.S. 316 (1819).....8

Offutt v. U.S., 348 U.S. 11 (1954).....7 n.7

Railway Labor Executives Ass'n v. Gibbons,
454 U.S. 457 (1982).....8

TrafFix Devices, Inc. v. Mktg. Displays, Inc.,
532 U.S. 23 (2001).....9 n.8

Waldman Publ'g Corp. v. Landoll, Inc.,
43 F.3d 775 (2d Cir. 1994).....4 n.4; 6 n.6

Wal-Mart Stores, Inc. v. Samara Bros., Inc.,
529 U.S. 205 (2000).....3; 6; 7

Woodford v. Visciotti, No. 02-137
(U.S., Nov. 4, 2002).....7 n.7

Briefs and Arguments in Pending Cases

Dastar Corp. v. Twentieth Century Fox Film Corp., No. 02-248 (U.S.)

Petition for a Writ of Certiorari.....1 n.2

Eldred v. Ashcroft, No. 01-618 (U.S.)

Brief for *Amici Curiae* The Intellectual Property Owners Ass'n in Support of Respondent.....8

Brief for the Respondent.....8

Brief of *Amicus Curiae* The Int'l Coalition for Copyright Protection in Support of Respondent.....8

Brief of Malla Pollack, *Amicus Curiae* Supporting Petitioners.....9

Oral Argument 8

Moseley v. V Secret Catalogue, No. 01-1015 (U.S.)

Brief of *Amicus Curiae* Malla Pollack 9 n.8

U.S. Constitution

Art. I., Sec. 8, cl. 3 (Commerce Clause).....2; 4; 8; 9 & n.8; 10

Art. I., Sec. 8, cl. 8 (Copyright and Patent Clause).....2; 3; 5; 8; 9 & n.8

Art. I, Sec. 8, cl. 18 (Necessary and Proper Clause).....8; 9

Statutes

Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998).....8; 9

Lanham Act, 15 U.S.C. §§ 1 *et. seq.*.....*passim*

15 U.S.C. § 1125(a).....6 & n.5

17 U.S.C. § 101 .....4 n.4

17 U.S.C. § 106.....5

17 U.S.C. § 106A(a).....4 n.4

28 U.S.C. § 2254(d).....7 n.7

Secondary Authorities

Mark Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 Yale L.J. 1687 (1999).....4

Robert Patrick Mergers & Glenn Harlan Reynolds, *The Proper Scope of the Copyright and Patent Power*, 2000 Harv. J. Leg. 46 (2000).....3

Malla Pollack, *The Right to Know?*, 17 Cardozo AELJ 47 (1999).....10 n.10

J.H. Reichman, *Legal Hybrids Between the Patent and Copyright Paradigms*, 94 Colum. L. Rev. 2432 (1994).....10 n.9

Interest of the *Amici Curiae*

Amici curiae are law professors specializing in trademark, copyright, and related subjects. None of *amici* have any financial interest in the outcome of this litigation.[1] *Amici* provide their institutional affiliation for identification purposes only; they do not purport to represent the opinions or interests of their institutions. *Amici*'s sole interest in this case is to encourage the proper unfolding of law in their areas of specialty.

Both parties have given permission for Pollack to file this *amicus* submission. Copies of the permission letters are attached to the proof of service submitted to the Clerk.

Summary of Argument

Petitioner, Dastar Corp., has fully briefed the multiple circuit split regarding Question One.[2] *Amici* write separately to make several other arguments supporting a grant of *certiorari* as to Question One.

Two of the three positions currently taken by federal circuits on Question One involve extreme departures from this Court's teachings on statutory construction. These positions raise serious constitutional issues unrequired by the statutory text. Furthermore, these misreadings of the Lanham

---

1. No party has authored this brief in whole or in part. The printing of this *amicus* filing was paid for by Malla Pollack with the generous support of the Cecil C. Humphreys School of Law of the University of Memphis.

2. "Does the Lanham Act protect creative works from uncredited copying even without a likelihood of consumer confusion?" Dastar Corporation's Petition for a Writ of Certiorari at i.

Act ignore its congressionally designated product identification purpose; instead, the Lanham Act becomes a barrier preventing public use of formerly copyrighted material, even without any likelihood of consumer confusion. Because these two positions are clearly erroneous as a basic matter of statutory construction, this Court could decide *Dastar* with little effort. This Court would not need to reach any constitutional issue.

Additionally, with the small effort required to exercise this Court's supervisory authority in *Dastar*, the Court will gain important assistance with a more complex case, *Eldred v. Ashcroft*, No. 01-618, questioning the constitutionality of the Copyright Term Extension Act. *Dastar Corp. v. Twentieth Century Fox Film Corp.* involves a related issue, the intersection between the Commerce and Copyright Clauses. The overlap in issues counsels that receiving briefs on *Dastar* will assist this Court to deal properly with the issues in *Eldred*. Furthermore, if this Court rules for Eldred, a reversal of *Dastar* would be essential both to prevent practical nullification of the Court's *Eldred* decision [3] and to limit commercial disruption.

Argument

I. Granting *certiorari* in this case is an appropriate use of this Court's supervisory power over the federal court system

A. Using the Lanham Act to extend copyright protection raises severe constitutional problems

---

3. Some of *amici* have signed briefs supporting Eldred in *Eldred v. Ashcroft*.

Copyrights, like patents, are constitutionally allowable only for "limited times." U.S. Const. Art. I, sec. 8, cl. 8. When such limited rights end, they end. *See, e.g., Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938) (holding that exclusive right in name and shape of product expire with the patents); *see also, e.g.*, Robert Patrick Mergers & Glenn Harlan Reynolds, *The Proper Scope of the Copyright and Patent Power*, 2000 Harv. J. Leg. 46, 62-63 (2000) (discussing public's remainder interest in formerly patented and copyrighted material). The public has some type of right to copy and use *res* outside of patent and copyright. Such general use is "the essence of copyright" and a constitutional requirement. Feist Publications, Inc. v. Rural Tel. Svc. Co., 499 U.S. 340, 349-50 (1991); *see also* Bonito Boats Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 164 (1989) (asserting public right to use unpatented technology "in the marketplace"). The extent of the public's right is, however, unclear.

This Court has suggested in dicta that government might have the power to require later users of uncopyrighted and unpatented *res* to take some steps to limit consumer confusion. *See, e.g., Bonito Boats*, 489 U.S. at 157 (stating in dicta that states may "protect[] consumers from confusion" about reused industrial designs under "unfair competition" statutes rooted in the "common law of deceit."); *Nabisco*, 305 U.S. at 120 ("The question remains whether Kellogg Company, in exercising its right to use the name 'Shredded Wheat' and the pillow-shaped biscuit, is doing so fairly. . . . in a manner which reasonably distinguishes its product from that of plaintiff."). Therefore, some labeling requirement or disclaimer might be constitutional if clearly required by statute. A clear statute would provide the notice necessary to prevent uneconomic, unconstitutional chilling effects. *See* Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 214 (2000) ("Competition is deterred, however, not merely

by successful suit but by the plausible threat of successful suit," therefore, the Court refuses to accept a vague test for Lanham Act protectibility of product aspects); Mark Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 Yale L.J. 1687, 1710-13 (1999) (discussing speech-chilling effects of trademark law suits, even unsuccessful suits). At some point, a labeling requirement, especially one that is unclear or imposed *ex post*, might be an unacceptable burden on the public's right to copy. However, the exact limit of such a labeling requirement is not presented in *Dastar*.

Dastar involves only the Ninth Circuit's test, which makes reuse of uncopyrighted copyrightable works a Lanham Act violation without any showing whatever that consumer confusion is likely.[4] The Ninth Circuit's version of the Lanham Act presents the conflict between the Commerce and

---

4. The Second Circuit's "substantial similarity" test is similarly flawed. *See* Waldman Publ'g Corp. v. Landoll, Inc., 43 F.3d 775, 783 - 84 & n.7 (2d Cir. 1994) (holding that Lanham Act claim asserting "false designation of origin," regarding two adaptations of public domain works, requires "substantial similarity," but not "secondary meaning"). The Second Circuit read into the Lanham Act a right of attribution, a right for the author's name to be attached to the work. *See Waldman*, 43 F.3d at 781. Congress, however, has created attribution rights for only a small set of "work[s] of visual art," 107 U.S.C. § 106A(a), which include neither the books at issue in *Waldman* nor the videos at issue in *Dastar*. *See* 107 U.S.C. 101 (defining "work of visual art" without including "literary works," and with express exclusion of both any "motion picture or other audiovisual work," and "any work made for hire").

Copyright Clauses in its most extreme form. By reversing the Lanham Act judgement against Dastar, this Court would remove the most constitutionally questionable reading of the Lanham Act — giving protection against mere copying to someone who had failed to fulfill the required formalities to perfect copyright in a copyrightable work. This Court would not need to reach the more difficult issue of Lanham Act protection for formerly copyrighted works in situations where consumer confusion is likely.

B. Congress has not legislated use of the Lanham Act to extend copyright protection

Statutory construction starts with the words of the statute. *See, e.g.,* Dept. of Housing & Urban Dev. v. Rucker, 122 S. Ct. 1230, 1233 (2002)(relying on "plain language of the statute."). Only extraordinary conditions, such as "serious constitutional problems" may counsel resorting to a "fairly possible" alternative. *See* INS v. St. Cyr, 533 U.S. 289, 299-300 (2001)(citations omitted).

The Ninth Circuit affirmed Lanham Act judgement against Dastar without any "independent showing that the [video] series manufactured by Dastar resulted in consumer confusion." Twentieth Century Fox Film Corp. v. Entertainment Distributing, No. 00-56703, at 3a (9th Cir., April 9, 2002) (as reproduced in Appendix to Dastar's Petition for Certiorari). The Ninth Circuit insisted that "the 'bodily appropriation' test subsumes the less demanding 'consumer confusion' standard." *Id.* at 4a (quoting Cleary v. News Corp., 30 F.3d 1255, 1261-62 (9th Cir. 1994)(internal quotation marks omitted). "Bodily appropriation," however, merely requires copying, a violation of the Copyright Act. *See* 17 U.S.C. § 106. The Lanham Act requires "likelihood

of confusion." 15 U.S.C. § 1125(a)(1).[5]

Before consumers can be confused, they must believe that the "bodily approriat[ed]" *res* functions as an indicia of origin. Not all product characteristics do so – whether the product is a writing or not. *See, e.g.,* Samara Bros., 529 U.S. at 213 (asserting that unregistered product configurations are unprotectible under the Lanham Act without evidence of secondary meaning because "consumer predisposition to equate the feature with the source does not exist); Comedy III Productions, Inc. v. New Line Cinema, 200 F.3d 593, 595 (9th Cir. 2000) (holding that reuse of uncopyrighted clip from Three Stooges movie did not constitute Lanham Act violation because plaintiff had not demonstrated "how the film footage could contain a distinctive mark or . . . have secondary meaning"; plaintiff had not "articulated a trademark interest in the clip.").

"Bodily appropriation" is a phrase completely absent from the Lanham Act. The Ninth Circuit has not pointed to any language contained in that statute which translates into "bodily appropriation."[6] Instead of reading the plain language of the Lanham Act, the Ninth Circuit has forcibly inserted constitutionally questionable provisions into Congress' enactments.

---

5. The district court based its Lanham Act holding on 15 U.S.C. § 1125(a)(1)(A). *See* Twentieth Century Fox Film Corp. v. Dastar Corp., No. CV 98-7189 FMC(Ex), n. 4 at 50a-51a (C.D. Cal., Jan. 4, 2000)(as reproduced in Appendix to Dastar's Petition for Certiorari).

6. Similarly, the Second Circuit's "substantial similarity" test was knowingly imported from copyright cases. It has no Lanham Act pedigree. *See Waldman*, 43 F.3d at 783.

C. This Court may solve the constitutional difficulty easily by requiring federal courts to heed statutory language

The Ninth Circuit has violated two of this Court's most basic instructions: to follow statutory language and to avoid constitutional problems. "[W]hen a particular interpretation of a statute invokes the outer limits of Congress' power, [the Court] expect[s] a clear indication that Congress intended that result." *St. Cry*, 533 U.S. at 299.

This Court can quiet constitutional questions by merely reminding the federal courts that statutory construction starts with the language of the statute. This Court need go no further to decide *Dastar*. Reminding federal judges of this most basic limit on judicial legislation would be a proper, useful, and relatively simple exercise of this Court's supervisory authority.[7] This Court could even grant certiorari and summarily reverse for reconsideration in light of Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205 (2000) (holding that unregistered product configuration marks are unprotectible without evidence of secondary meaning).

---

7. This Court has repeatedly used its supervisory authority to assure that federal judges act with appropriate "alert self-restraint." *See, e.g.,* Offutt v. U.S., 348 U.S. 11, 13 (1954) (providing this explanation for Supreme Court's willingness to review contempt orders). *See also* Woodford v. Visciotti, No. 02-137 (U.S., Nov. 4, 2002) (*per curium* reversal of grant of habeas relief because granting federal courts failed to heed limiting language of 28 U.S.C. § 2254(d)); Early v. Packer, No. 01-1765 (U.S., Nov. 4, 2002) (same).

II. Granting *certiorari* in this case would assist the Court in deciding *Eldred v. Ashcroft*

Eldred v. Ashcroft may be the most important copyright case the Court has ever decided. After over 200 years of hints, the Court finally has agreed to measure the public's remainder interest in the writings of authors pursuant to U.S. Const. Art. I, sec. 8, cl. 8 ("the Copyright and Patent Clause"). Delay in reaching this issue has already had an obvious cost — the weight of prior, constitutionally questionable, Congressional actions and the commercial relationships formed in reliance on these actions. *See* Oral Argument 8-9, *Eldred v. Ashcroft* (U.S. No. 01-618) ("[I]f we agree with [Eldred], does that mean that we would, in principle, have to hold the 1976 extension unconstitutional?. . . . [T]he chaos that would ensue would be horrendous," question from the Court), *available at* <http://www.SupremeCourtus.gov/oral_arguments/argument_transcript/01-618.pdf>. *But see id.* at 9-10 (Larry Lessing responding that older act might be preserved under "severe disruption exception" to retroactivity).

In support of the challenged Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998), partisans have marshaled the Commerce Clause and the Necessary and Proper Clause. See Eldred v. Ashcroft, No. 01-618 (U.S.), Brief for the Respondent 28 (relying on Necessary and Proper Clause); Brief for *Amici Curiae* The Intellectual Property Owners Ass'n in Support of Respondent 9-19 (relying on Commerce Clause); Brief of *Amicus Curiae* The Int'l Coalition for Copyright Protection in Support of Respondent 3-22 (relying on Commerce Clause and Necessary and Proper Clause). *But see* Railway Labor Executives Ass'n v. Gibbons, 454 U.S. 457 (1982) (undermining use of Commerce Clause) and M'Cullouch v. Md., 17 U.S. 316 (1819) (undermining use of Necessary and

Proper Clause). *See also, e.g.*, Eldred v. Ashcroft, No. 01-618 (U.S.), Brief of Malla Pollack, *Amicus Curiae* Supporting Petitioners 5 n.5 (explaining how these cases undercut use of Commerce Clause or Necessary and Proper Clause as foundations for the Copyright Term Extension Act).

Missing from the *Eldred* briefs, however, are the view points of numerous parties who have experienced attempts to use the Commerce Clause-based Lanham Act to bypass copyright – such as the litigants in *Dastar*. Full, informed briefing is the life-blood of accurate decision making by courts in an adversary system of justice. *See, e.g.*, Christiansburg Garment Co. v. EEOC, 434 U.S. 410, 420 (1978) ("A fair adversary process presupposes both a vigorous prosecution and a vigorous defense.").

Granting *certiorari* in *Dastar*, therefore, would provide this Court with valuable input on the problems involved in allowing Commerce Clause extension of the Copyright and Patent[8] Clause. Briefs in *Dastar* would assist this Court in deciding *Eldred*.

Obtaining these briefs would not exact a high price from this Court, because *Dastar* can be decided easily on statutory grounds. *See supra* Section I.

---

8. The patent version of this problem was recently reserved by this Court in TrafFix Devices, Inc. v. Mktg. Displays, Inc., 532 U.S. 23, 35 (2001). The issue of the Copyright and Patent Clause's interaction with the Commerce Clause, however, stubbornly rerises in another of this term's cases. *See* Moseley v. V Secret Catalogue, No. 01-1015 (U.S.) Brief of *Amicus Curiae* Malla Pollack 21-25.

III. A Court decision for Eldred would be almost a nullity unless *Dastar* is reversed

The Lanham Act has burgeoned as the protection of last resort for numerous would-be-right-holders unsheltered by patent or copyright.[9] If this Court decides for Eldred, disappointed copyright monopolists undoubtedly will attempt to stretch the Lanham Act or to obtain other Commerce Clause havens.[10]

Absent reversal of *Dastar*, losing special interests will not even have to convince Congress to enact a new statute. These entities will simply claim the type of quasi-copyright protection allowed by the Ninth Circuit to Twentieth Century Fox Film Corporation pursuant to the Lanham Act. *See Dastar*. Such Lanham Act based quasi-copyright protection would render this Court's decision in *Eldred* a practical nullity in two sets of circuits.

Additionally, a Noah's Flood of unnecessary litigation would wash across the federal court system.

---

9. *See, e.g.*, J.H. Reichman, *Legal Hybrids Between the Patent and Copyright Paradigms*, 94 Colum. L. Rev. 2432, 2463 (1994) (asserting that common judicial stretching of unfair competition law "trigger[s] new forms of government overprotection that are still more anticompetative than [judicial over stretching of] the exclusive rights of copyright law.").

10. Feist Publications, Inc. v. Rural Tel. Svc., 499 U.S. 340 (1991)(holding collected facts uncopyrightable), prompted loud calls for *sui generis* database protection statutes. *See, e.g.*, Malla Pollack, *The Right to Know?*, 17 Cardozo AELJ 47, 58 n.62 (1999)(collecting sources).

Intelligent copyright holders would race to the courthouse to make sure that their quasi-copyright issue was decided under the legal doctrine of their choice. For the same reason, intelligent, commercial users of formerly copyrighted material would race to the courthouse in the third set of circuits. Eventually, this Court would grant *certiorari* to decide the three-way circuit split which it could decide now – before commercial and legal confusion escalate into a wild waste of resources.

Conclusion

For all the reasons discussed above, this Court should grant *certiorari* at least on Petitioner's Question One.

Respectfully submitted
November 18 2002,

Malla Pollack, Esq
Visiting Associate Professor[11]
Cecil C. Humphreys School of Law
University of Memphis
3715 Central Ave.
Memphis, TN 38152-3140
(tel) 901-678-1393
(fax) 901-678-5210
mpollack@memphis.edu

and *amici* listed below:

---

11. Institutions are provided for identification purposes only. None of law professor *amici* purport to represent the position of their respective institutions.

Professor Eugene Clark
Law School, University of Canberra
Canberra, Australian Capital Territory
Australia, 2601

Professor Ralph D. Clifford
Southern New England School of Law
333 Faunce Corner Rd.
N. Dartmouth, MA 02747

Professor Thomas G. Field, Jr.
Franklin Pierce Law Center
2 White Street
Concord, New Hampshire 03301

Professor Shuba Ghosh
University at Buffalo Law School, SUNY
724 O'Brien Hall, North Campus
Buffalo, New York 14260-1100

Professor Glen Harlan Reynolds
College of Law
Univ. of Tennessee
1505 W. Cumberland Ave.
Knoxville, TN 37996-1810

Tyler T. Ochoa, Professor and Co-Director
Center for Intellectual Property Law,
Whittier Law School, California

Professor Lyman Ray Patterson
University of Georgia
School of Law
Herty Drive
Athens, Georgia 30602